

REMARKS

Claims 1 and 3 are currently pending in the instant application. Claims 1 and 3 are independent. Claims 1 and 3 are presented to the Examiner for further prosecution on the merits.

A. Introduction

In the outstanding Office Action Made Final dated September 23, 2004, and as maintained in the Advisory Action dated January 26, 2005, the Examiner rejected claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,216,321 to Kawamura et al. (“the Kawamura et al. reference”), and rejected claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by Japanese Application Publication No. 6,036,710 to Makoto (“the Makoto reference”). These rejections are respectfully traversed for at least the reasons set forth in the previous Amendment filed December 23, 2004, and withdrawal thereof is still requested.

B. Finality of the Office Action Dated September 23, 2004, Is Premature

Applicants filed a reply on June 29, 2004, in response to the Office Action Made Final mailed April 29, 2004. Applicants’ representative then telephoned the Examiner to schedule an in-person interview. On July 28, 2004, the Applicants’ representative finally spoke with the Examiner, but the request for an interview was denied by the Examiner on the basis that the request was being made after a final Office action. Applicants advised the Examiner that a Request for Continued Examination (“RCE”) would be filed along with a written request for an interview with the Examiner in order to afford the Examiner time to receive the RCE and have an opportunity to review the file before conducting the in-person interview. The Examiner issued an Advisory Action mailed August 11, 2004, wherein the obviousness type double patenting rejection of claims 1 and 3 was indicated as being overcome, but the art-based rejection was not.

On September 13, 2004, applicants filed a RCE along with APPLICANT INITIATED INTERVIEW REQUEST, wherein applicants wrote:

Prior to issuance of the next Action on the merits, Applicants hereby request a personal interview with the Examiner.

Tentative participants would be:

For Applicants: Eugene M. Lee, Reg. No. 32039
 and/or Susan S. Morse, Reg. No. 35,292

For PTO: Examiner Ashok Patel and/or
 SPE, Art Unit 2879.

It is not anticipated that an exhibit would be shown or demonstrated.

Issues/Claims to be Discussed: Claims 1 and 3, and the outstanding rejection as set forth in the Final Rejection of April 29, 2004.

Applicants' counsel will telephone Examiner Patel within the next four weeks in an attempt to schedule this personal interview. However, as counsel cannot anticipate when this application will be scheduled for further Action by the Examiner, it is requested that, should a specific date for the interview not have been scheduled when the Examiner takes this application up for further action, he/she contact counsel by telephone at the number given below. Every effort will be made to meet the Examiner's scheduling preference.

APPLICANT INITIATED INTERVIEW REQUEST, filed September 13, 2004.

Exhibiting total disregard to the provisions of M.P.E.P. § 706.07(b), the Examiner ignored Applicants' request, and issued an Office Action Made Final on the merits on the first action on September 23, 2004. Upon receipt of the Office Action Made Final, Applicants' representative telephoned the Examiner to inquire as to why the Examiner had ignored applicants' request for an interview and, instead, had issued an Office Action Made Final. The Examiner responded by agreeing to an in-person interview.

The in-person interview with the Examiner was conducted on October 13, 2004, during which Applicants' representative explained the significance of the "transmission ratio"

in the claim language. The Examiner acknowledged this significance, but indicated to applicants' representative his preference that the claims be amended to include structural limitation to this effect. Indeed, as reflected in the Interview Summary of October 13, 2004, the Examiner noted:

Ms. Susan [Morse, Applicants' representative] proposed amendment of claims 1 and 3 so as to distinguish the "claimed structure" of the invention. Upon receipt of a formal amendment (reflecting the proposed amendment), the Examiner will issue next office action accordingly.

Interview Summary, October 13, 2004.

Applicants then prepared and filed an Amendment on December 23, 2004, in which the claims were amended as in the present amendment. In the interview summary portion of the Amendment, the Applicants stated:

The Examiner indicated some limitation regarding the respective thickness of the central and peripheral region would be more appropriate. The present amendments to the claims are believed to address these issues. The indication that the Examiner would enter and consider an amendment filed at this stage, in accordance with MPEP § 706.07(b), is also gratefully acknowledged.

Amendment dated December 23, 2004, p. 4.

Given the procedural posture, the granting of the in-person interview, the Examiner's representations at that interview, and the Examiner's indication that another Office action would be issued "accordingly," the Applicants were reasonably expecting a substantive action on the merits of the amended claims. Instead, after over one (1) month from the filing of the amendment, the Examiner merely issued an Advisory Action mailed January 26, 2005, cursorily stating that the applied art taught the structural limitations. In particular, the Examiner marked the Advisory Action to indicate that the proposed amendments would not be entered because "they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal" and that, "[f]or purposes of Appeal,

the proposed amendments will not be entered." On the continuation sheet, the Examiner perfunctorily noted:

Newly added structural limitations in claims 1 and 3 are not sufficient to distinguish the claimed structure from that of the prior art of record. The newly added limitations in claims 1 and 3, appear to be disclosed in, or taught by, the prior art of the record. As discussed during the interview, the claims need to recite a specific structure that is not disclosed in, or taught by, the prior art of the record.

Advisory Action, mailed January 26, 2005, continuation sheet.

It is respectfully requested that the finality of the Office action dated September 23, 2004, be withdrawn, and the present amendment be entered, and failing that, Applicants believe that under the present circumstance, a petition under 37 C.F.R. § 1.181 may be warranted.

C. Amended Claims Are Clearly in Better Form

The indication in the Advisory Action that the Examiner considered the amendment filed at this stage is acknowledged. However, it is respectfully submitted that the Examiner's assertion that the cited art discloses the added structural limitations is unsupported and uncorroborated. Further, it is respectfully submitted that the assertion by the Examiner that the claims as amended are not in better form for appeal is wholly unsubstantiated.

In the amendment allegedly "considered," which has been resubmitted here, as it was previously refused entry by the Examiner, positive structural limitations have been included to recite features explicitly not given patentable weight previously by the Examiner. In particular, the Examiner previously stated that:

The new limitation "the panel is formed of a transparent glass having a transmission ratio of 60% or more", is narrative in form and does not include any positive structure and therefore carry a patentable weight.

Office Action Made Final mailed April 29, 2004, p. 4.

In the Office Action Made Final mailed September 23, 2004, the Examiner stated that:

As to the newly added limitation "a glass having a transmission ratio of 60% or more", it is narrative in form and therefore does not carry any patentable weight. In order to be given patentable weight, a functional recitation must be [stet] expresses [stet] a "means" for performing the specified function, as set forth in 35 U.S.C. 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

Office Action Made Final dated September 23, 2004, p. 3.

The Examiner also argued that since the panel of either cited art was also formed of glass, it would inherently transmit at the recited ratio. *Id.*, p. 5 and p. 6. Thus, it appeared the Examiner was misinterpreting the recited transmission ratio as the transmission rate, as argued in the Reply filed by Applicants on June 29, 2004.

The Examiner also finally clarified that it was not the composition of the glass that made the limitation of the transmission ratio inherent, but the teaching of the cited art regarding the structural limitations that made this allegedly inherent. *Id.*, p. 4.

As noted above, an in-person interview with the Examiner was conducted on October 13, 2004, during which Applicants' representative explained the significance of the "transmission ratio" in the claim language. Based on the representation by the Examiner in the Office Action Made Final dated September 23, 2004, that "means plus function" language would be appropriate, the Applicant's representative presented to the Examiner proposed claim amendments that recited the limitation in "means plus function" format at the interview. *See Proposed Claim Amendments, faxed October 12, 2004.* Nevertheless, at the interview, the Examiner, apparently changing his mind, indicated that a still more positive structure would be needed, and that such amended claims would be considered. The Examiner's requirement of a more positive structural limitation is evident from the Examiner's Interview Summary, which indicated the claims were to be amended to

“distinguish the ‘claimed structure’ of the invention.” *Examiner’s Interview Summary dated October 13, 2004.*

In an effort to yet again comply with the Examiner’s new position, Applicants filed the Amendment dated December 23, 2004, to recite structural limitations in the independent claims 1 and 3. Since the Examiner has consistently characterized the previous recitation as “narrative” and “inherent,” the positive structural limitations now presented clearly place the claims in better form and reduce issues, contrary to the assertion by the Examiner in the Advisory Action mailed January 26, 2005.

Therefore, it is respectfully requested that the present amendment be entered and duly considered.

D. Arguments Filed December 23, 2004.

Since the Amendment filed December 23, 2004, was refused entry, Applicants duplicate the arguments contained in the Amendment filed December 23, 2004, below.

1. Synopsis of Claimed Invention

Both claims 1 and 3 recite that a glass having the outer and inner surfaces has “a first thickness in a central area of the panel and a second thickness in the peripheral areas of the panel, a ratio of the first thickness to the second thickness providing a ratio of transmission in the peripheral areas to that of the central area of 60% or more.” As noted, for example, on page 8, lines 14-22 of the original specification, since the panel is thicker in the peripheral areas than in the central areas, luminance in the peripheral areas is reduced relative to the central areas. In order to solve this problem, an embodiment of the present invention forms the panel of a glass having a transmission *ratio*, i.e., a ratio of transmission in the peripheral areas to that of the central areas, of 60% or higher. Since there is a limit on how transmissive

glass of a certain thickness can be, this may involve sacrificing some brightness in the central areas to gain uniformity, or limiting the amount of curvature on the inner surface.

2. Asserted Rejection Under 35 U.S.C. § 102 (b) Over the Kawamura et al. Reference

The rejection of claims 1 and 3 as being anticipated by the Kawamura et al. reference is respectfully traversed for at least the reasons set forth below.

In addressing the limitation regarding the transmission ratio in the outstanding Office action, the Examiner asserted:

As to the newly added functional limitation “a glass having a transmission ratio of 60% or more,” is narrative in form and therefore does not carry any patentable weight.

Office action of September 23, 2004, at p. 3.

There is no disclosure or suggestion in the Kawamura et al. reference that this thickness presents any problems or to providing a transmission ratio of 60% or more. It is respectfully submitted that such a transmission ratio is not inherent in the use of glass for the panel. It is also respectfully submitted that the relative thicknesses now recited in claims 1 and 3 are clearly structural limitations that must be afforded weight and are not disclosed or suggested by the Kawamura et al. reference.

Therefore, it is respectfully submitted that the Kawamura et al. reference fails to disclose or suggest the present invention as recited in claims 1 and 3, and it is respectfully requested that this rejection be withdrawn.

3. Asserted Rejection Under 35 U.S.C. § 102(b) Over the Makoto Reference

The rejection of claims 1 and 3 as being anticipated by the Makoto reference is respectfully traversed for at least the reasons set forth below. The Examiner applied the same reasoning in addressing the transmission ratio limitation as discussed above in connection with the rejection over the Kawamura et al. reference.

As clarified by the Synopsis above, the claimed transmission ratio is not the same as the inherent transmission rate of the glass, but is controlled across the panel to make the brightness of the image more uniform.

In contrast, the Makoto reference discloses improving flatness and reducing glare by forming the front face of a display into a concave structure. While the resulting faceplate appears to be thicker in the peripheral portion than in the central portion thereof, there is apparently no disclosure or suggestion in the Makoto reference that this thickness presents any problems or the relationship between the thicknesses of the central and peripheral portions regarding a transmission ratio of 60% or more. It is respectfully submitted that such a transmission ratio is not inherent in the use of glass for the panel. It is also respectfully submitted that the relative thicknesses now recited in claims 1 and 3 are clearly structural limitations that must be afforded weight and are not disclosed or suggested by the Makoto reference.

Therefore, it is respectfully submitted that the Makoto reference fails to disclose or suggest the present invention as recited in claims 1 and 3, and it is respectfully requested that this rejection be withdrawn.

E. Conclusion

Since the cited prior art references relied upon by the Examiner in rejecting the claims neither anticipate nor render obvious the subject invention as presently claimed, applicants respectfully submit that claims 1 and 3 are now in condition for allowance, and a notice to that effect is respectfully requested.

It is respectfully requested that indication of withdrawal of the finality of the Office action, and the issuance of a new action on the merits be performed **expeditiously**, to avoid the necessity of Applicants having to file a petition.

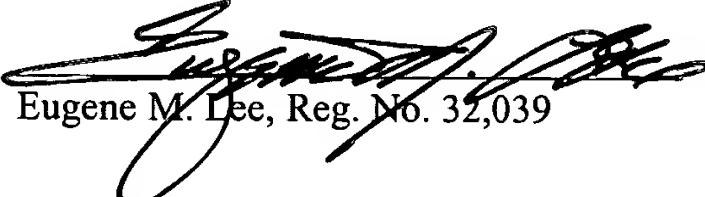
If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing remarks, reconsideration and withdrawal of all objections and rejections are respectfully requested.

Respectfully submitted,

LEE, STERBA & MORSE, P.C.

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Eugene M. Lee, Reg. No. 32,039

LEE, STERBA & MORSE, P.C.
1101 WILSON BOULEVARD, SUITE 2000
ARLINGTON, VA 22209
703.525.0978 TEL
703.525.4265 FAX

PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.